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EXAMINER

ZHEN, LI B

ART UNIT	PAPER NUMBER
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2194

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/607,907

Applicant(s)

SNADER ET AL.

Examiner

Li B. Zhen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,9-19,23-26,28-30,50,53-65,67-71,74-78,80-89 and 92-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,9-19,23-26,28-30,50,53-65,67-71,74-78,80-89 and 92-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/8/06; 6/28/06; 6/28/06.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 4 – 6, 9 – 19, 23 – 26, 28 – 30, 50, 53 – 65, 67 – 71, 74 – 78, 80 – 89 and 92 – 101 are pending in the application.

Response to Arguments

2. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5, 6, 24, 25, 54, 55, 70, 71, 88 and 89 contain the trademark/trade name "ActiveX" or "Netscape". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a web browser extension and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 1, 4 – 6, 9 – 19, 23 – 26, 28 – 30, 50, 53 – 65, 67 – 71, 74 – 78, 80 – 89 and 92 – 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0152332 to Rensin et al. [hereinafter Rensin, cited in the previous office action] in view of U.S. Patent Application Publication No. 2004/0093317 to Swan.**

8. As to claim 1, Rensin teaches the invention substantially as claimed including a method performed with a computing device, the method comprising the steps of:

mapping one or more fields [p. 5, paragraph 0061] of contact data [allow the user to easily and quickly select an address from the local database associated with the address book application; p. 6, paragraph 0066] from personal information manager (PIM) software [PIM applications including an address book; p. 3, paragraph 0038] to one or more corresponding fields of the web page of a web application to produce a mapping [p. 4, paragraph 0044];

entering one or more alphanumeric characters into a field of a web page of the application [menu lists items that may be selected by the user to fill the fields of an on-line form in web site 23; p. 4, paragraph 0046];

displaying one or more sets of contact data that match the entered alphanumeric characters ["Get Contact" button invokes database browser 29 to list the data entries stored in the local database corresponding to the address book application; pp. 4 – 5, paragraph 0054];

selecting one of the displayed sets of contact data to be mapped to the fields of the web page [user may then proceed to select a data record saved in a local database in the handheld Internet appliance to fill out the on-line form corresponding to the destination address; p. 5, paragraph 0055]; and

transmitting the web page containing mapped data as output data to a web server executing the web application via a communication network [menu item 45b is selected by the user, a local database containing the data records that may be entered into the given field of the on-line form is displayed to the user by means of database browser; p. 5, paragraph 0059]. Although Rensin teaches the invention substantially,

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Rensin does not specifically teach searching the contact data using interface software for one or more sets of contact data matching the entered alphanumeric characters using the mapping data and mapping one or more fields of the selected set of contact data to the one or more corresponding fields of the web page of the web application to automatically populate the web page using the mapping data.

However, Swan teaches mapping one or more fields of contact data from personal information manager (PIM) software [p. 14, paragraph 0155], searching the contact data using interface software for one or more sets of contact data matching the entered alphanumeric characters using the mapping data [search criteria to hub 12. Based on that information, hub 12 will: retrieve contact information for the indicated contact; p. 7, paragraph 0081], displaying one or more sets of contact data that match the entered alphanumeric characters [Software at the end user 21's terminal preferably automatically saves and/or displays the received contact information; p. 7, paragraph 0081], selecting one of the displayed sets of contact data to be mapped to the fields of the web page [p. 8, paragraph 0096], mapping one or more fields of the selected set of contact data to the one or more corresponding fields of the web page of the web application to automatically populate the web page using the mapping data [pp. 18 – 19, paragraph 0217], and transmitting the web page containing mapped data as output data to a web server executing the web application via a communication network [p. 4, paragraph 0050].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Rensin to incorporate the features of

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Swan because this provides a method for controlling, distributing and receiving contact information [p. 2, paragraph 0014 of Swan] and provides a central hub which maintains contact records for a number of different contacts and facilitate sharing of contact information [p. 2, paragraph 0015 of Swan].

9. As to claim 4, Rensin teaches the mapping data maps the field of contact data to the corresponding field of the web application [User interface 26 lists items that may be selected by the user to fill the fields of an on-line form; p. 4, paragraph 0051] via a browser extension embedded in the web page of the application [Software plug-in 27 implements the functions required to fill an on-line form with data records from a local database in handheld Internet appliance 20; p. 4, paragraph 0049].

10. As to claim 5, Rensin teaches the extension is an ActiveX® control [p. 4, paragraph 0049].

11. As to claim 6, Rensin teaches the extension is a Netscape® plug-in [p. 2, paragraph 0023].

12. As to claim 9, Rensin as modified teaches outputting the mapped contact data generated by automatically populating the contact data to the application to an output device [p. 9, paragraph 101 of Swan].

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13. As to claim 10, Rensin as modified teaches the output device generates a printed document based on the mapped contact data [p. 9, paragraph 101 of Swan].

14. As to claim 11, Rensin teaches wherein the communication network is the Internet [Internet 22; p. 3, paragraph 0038].

15. As to claim 12, Rensin teaches the contact data comprises a person's name [pp. 4 – 5, paragraph 0054].

16. As to claim 13, Rensin teaches the contact data comprises a company name [p. 5, paragraph 0058].

17. As to claim 14, Rensin teaches the contact data comprises an address [p. 5, paragraph 0058].

18. As to claim 15, Rensin teaches the contact data comprises a telephone number [p. 5, paragraph 0061].

19. As to claim 16, Rensin the contact data comprises a mobile number [p. 3, paragraph 0038 and p. 5, paragraph 0061].

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20. As to claim 17, Rensin the contact data comprises a facsimile number [p. 4, paragraph 0044].

21. As to claim 18, Rensin teaches the contact data comprises an email address [p. 4, paragraph 0045].

22. As to claim 19, Rensin as modified teaches receiving mapping software [transcoding server 25 inserts user interface 26 on web site 23 with links to software plug-in 27; p. 4, paragraph 0046 of Rensin] at a computing device from a public communications network [Users of handheld Internet appliance 20 connect to Internet 22 to access e-mail and various web pages, such as web site 23; p. 4, paragraph 0045 of Rensin], the mapping software [Database browser; p. 6, paragraph 0066 and p. 4, paragraph 0051 of Rensin] for generating mapping data [selected address is then automatically entered into the destination address field of the on-line form; p. 6, paragraph 0066 of Rensin] that maps at least one field of contact data [data record of Rensin] from a personal information manager (PIM) software [PIM applications including an address book; p. 3, paragraph 0038 of Rensin] to at least one corresponding field of a web application [User interface 26 consists of a button that, when tapped, displays a menu for getting a data record from a local database in handheld Internet appliance 20. The menu lists items that may be selected by the user to fill the fields of an on-line form in web site 23; p. 4, paragraph 0046 of Rensin]; and

receiving interface software [p. 5, paragraph 0063 of Swan] for automatically populating the web page of the web application with contact data based on the mapping data generated by the mapping software [pp. 18 – 19, paragraph 0217 of Swan], the interface software enabling a user of the computing device to enter one or more alphanumeric characters [p. 7, paragraph 0081 of Swan], and the interface software generating a display of one or more sets of contact data matching the one or more alphanumeric characters entered by the user [p. 7, paragraph 0081 of Swan], the user selecting from among the displayed sets of contact data to populate the web page of the web application [p. 8, paragraph 0096 of Swan].

23. As to claim 23, Rensin teaches the interface software comprises a browser extension embedded in the web page of the web application [Software plug-in 27 implements the functions required to fill an on-line form with data records from a local database in handheld Internet appliance 20; p. 4, paragraph 0049] by a web browser of the computing device [p. 3, paragraph 0039].

24. As to claim 24, Rensin teaches the browser extension is an ActiveX® control [p. 4, paragraph 0049].

25. As to claim 25, Rensin teaches the browser extension is a Netscape® plug-in [p. 2, paragraph 0023].

26. As to claim 26, Rensin as modified teaches a method comprising: receiving interface software [transcoding server 25 inserts user interface 26 on web site 23 with links to software plug-in 27; p. 4, paragraph 0046 of Rensin] at a computing device from a public communications network [Users of handheld Internet appliance 20 connect to Internet 22 to access e-mail and various web pages, such as web site 23; p. 4, paragraph 0045 of Rensin], the interface software [Database browser; p. 6, paragraph 0066 and p. 4, paragraph 0051 of Rensin] for automatically populating the web page of the web application with contact data based on the mapping data generated by the mapping software. [User interface 26 consists of a button that, when tapped, displays a menu for getting a data record from a local database in handheld Internet appliance 20. The menu lists items that may be selected by the user to fill the fields of an on-line form in web site 23; p. 4, paragraph 0046 of Rensin], the interface software enabling a user of the computing device to enter one or more alphanumeric characters [p. 7, paragraph 0081 of Swan], and the interface software generating a display of one or more sets of contact data matching the one or more alphanumeric characters entered by the user [p. 7, paragraph 0081 of Swan], the user selecting from among the displayed sets of contact data to populate the web page of the web application [p. 8, paragraph 0096 of Swan].

27. As to claim 28, Rensin teaches the interface software comprises a browser extension embedded in the web page of the web application [Software plug-in 27 implements the functions required to fill an on-line form with data records from a local

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database in handheld Internet appliance 20; p. 4, paragraph 0049] by a web browser of the computing device [p. 3, paragraph 0039].

28. As to claim 29, Rensin teaches the browser extension comprises an ActiveX® control [p. 4, paragraph 0049].

29. As to claim 30, Rensin teaches the browser extension comprises a Netscape® plug-in [p. 2, paragraph 0023].

30. As to claim 50, Rensin teaches transmitting interface software for automatically populating a web application with contact data [selected address is then automatically entered into the destination address field of the on-line form; p. 6, paragraph 0066 of Rensin] from personal information manager (PIM) software [PIM applications including an address book; p. 3, paragraph 0038 of Rensin] based on mapping data [p. 4, paragraph 0046 of Rensin], the interface software [p. 5, paragraph 0063 of Swan] enabling a user of a computing device to enter one or more alphanumeric characters [p. 7, paragraph 0081 of Swan], and the interface software generating a display of one or more sets of contact data matching the one or more alphanumeric characters entered by the user [p. 7, paragraph 0081 of Swan], the user selecting from among the displayed sets of contact data to populate a web page of the web application [p. 8, paragraph 0096 of Swan].

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31. As to claims 53 – 55, these claims recite the same features that are presented in corresponding claims 28 – 30, see the rejections to claims 28 – 30 above, which also meet these claims.

32. As to claim 56, Rensin teaches the interface software is transmitted by a server over a public communications network to a computing device for execution thereon [p. 4, paragraph 0045].

33. As to claim 57, Rensin teaches the public communications network is the Internet [Internet 22; p. 3, paragraph 0038].

34. As to claims 58 – 64, these claims recites the same features that are presented in corresponding claims 12 – 18, see the rejections to claims 12 – 18 above, which also meet these claims.

35. As to claim 65, Rensin as modified teaches an apparatus comprising:
a computing device [p. 4, paragraph 0045 of Rensin] executing interface software to map contact data [p. 6, paragraph 0066 of Rensin] from personal information manager (PIM) software to automatically populate a web application [p. 4, paragraph 0046 of Rensin], a user of the web application using the computing device to enter one or more alphanumeric characters into a field of a web page of the web application [p. 7, paragraph 0081 of Swan], the computing device searching the contact data of the PIM

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software to display one or more sets of contact data matching the one or more alphanumeric characters entered [p. 7, paragraph 0081] for the user to select for mapping to the one or more fields of the web page [p. 8, paragraph 0096 of Swan], the computing device transmitting the web page populated with contact data via a public communications network to a server executing the web application [p. 4, paragraph 0050 of Swan].

36. As to claim 67, Rensin as modified teaches the mapping is performed by the computing device using mapping data that defines the mapping of at least one field contact data from the PIM software to at least one corresponding field of the web page [pp. 18 – 19, paragraph 0217 of Swan].

37. As to claim 68, Rensin teaches the mapping data is defined through execution of mapping software by the computing device so that the user can specify the mapping of fields of the contact data to corresponding fields of the web page [p. 4, paragraph 0046].

38. As to claims 69 – 71 and 76, these are apparatus claims that correspond to method claims 4 – 6 and 11; see the rejections to claims 4 – 6 and 11 above, which also meet these apparatus claims.

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39. As to claims 74 and 75, these are apparatus claims that correspond to method claims 9 and 10; see the rejections to claims 9 and 10 above, which also meet these apparatus claims.

40. As to claim 77, this is an apparatus claim that is a combination of method claims 12 – 18, see the rejections to claims 12 – 18 above, which also meet these apparatus claims.

41. As to claim 78, Rensin as modified teaches a system using a public communications network [Internet 22; p. 3, paragraph 0038 of Rensin], the system comprising:

a web server [p. 1, paragraph 0005 of Rensin] having a web application with at least one web page [web site 23, Fig. 1; p. 4, paragraph 0045 of Rensin], and a set-up file with mapping software and interface software [transcoding server 25 inserts user interface 26 on web site 23 with links to software plug-in 27; p. 4, paragraph 0046 of Rensin]; and

a computing device [Internet appliance 20, Fig. 1; p. 3, paragraph 0038 of Rensin] connected to communicate with the web server [p. 1, paragraph 0005 and p. 4, paragraph 0045 of Rensin] via the public communications network [Internet 22; p. 3, paragraph 0038 of Rensin], and having personal information manager (PIM) software [PIM applications including an address book; p. 3, paragraph 0038 of Rensin] storing contact data [p. 3, paragraph 0039 of Rensin],

the web server transmitting the set-up file [transcoding server 25 inserts user interface 26 on web site 23 with links to software plug-in 27; p. 4, paragraph 0046 of Rensin] to the computing device via the public communications network [Users of handheld Internet appliance 20 connect to Internet 22 to access e-mail and various web pages, such as web site 23; p. 4, paragraph 0045 of Rensin],

the computing device receiving the set-up file from the web server [At step 37, the user launches a web site containing on-line forms; p. 5, paragraph 0055 of Rensin] and executing the mapping software [Database browser; p. 6, paragraph 0066 and p. 4, paragraph 0051 of Rensin] to map at least one field of contact data [allow the user to easily and quickly select an address from the local database associated with the address book application; p. 6, paragraph 0066 of Rensin] from the PIM software [PIM applications including an address book; p. 3, paragraph 0038 of Rensin] to at least one field of a web page of the web application to generate mapping data [selected address is then automatically entered into the destination address field of the on-line form; p. 6, paragraph 0066 of Rensin], and the computing device executing the interface software to enable a user of the computing device to enter one or more alphanumeric characters into a field of the web page of the web application [p. 7, paragraph 0081 of Swan], the computing device executing the interface software to search contact data of the PIM software to display one or more sets of contact data matching [p. 7, paragraph 0081 of Swan], the one or more alphanumeric characters entered by the user [p. 7, paragraph 0081 of Swan], the computing device further executing the interface software to enable the user to select a displayed set of contact data [p. 8, paragraph 0096 of Swan], the

computing device mapping the selected set of contact data to at least one field of the web page of the web application based on the mapping data, to automatically populate the field of the web page with corresponding contact data [pp. 18 – 19, paragraph 0217 of Swan], the computing device transmitting the web page with populated data to the web server via the public communications network for processing by the web application executed by the web server [p. 4, paragraph 0050 of Swan].

42. As to claims 80 and 81, these claims recites the same features that are presented in corresponding claims 9 and 10, see the rejections to claims 9 and 10 above, which also meet these claims.

43. As to claim 82, Rensin teaches the public communications network is the Internet [Internet 22; p. 3, paragraph 0038].

44. As to claim 83, Rensin teaches the contact data comprises at least one of a person's name, a company name, an address, a telephone number, a mobile number, a facsimile number, and an email address [p. 4, paragraph 0052, see also the rejections for claims 12 – 18 above].

45. As to claim 84, Rensin as modified teaches a computer-readable medium having a computer program executable by a computer to enable a user to enter one or more alphanumeric characters into a field of a web page of a web application [p. 7, paragraph

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0081 of Swan], the computer program executable by the computing device to display one or more sets of contact data matching the one or more alphanumeric characters for the user to select for mapping to the fields of the web page [p. 7, paragraph 0081 of Swan], the computer program mapping the selected contact data [p. 6, paragraphs 0066 and 0096 of Rensin] from personal information manager (PIM) software to the field of the web page to automatically populate a web application with contact data [p. 4, paragraph 0046 of Rensin], the computer program further executable by the computer to transmit the web page populated with the contact data via a public communications network to a web server executing the web application [p. 4, paragraph 0050 of Swan].

46. As to claim 85, Rensin as modified teaches the mapping of the contact data is performed to map one or more fields of contact data to one or more corresponding fields of a web page of the web application [pp. 18 – 19, paragraph 0217 of Swan].

47. As to claim 86, Rensin teaches the mapping is performed using mapping data that defines the mapping of at least one field of the contact data from the PIM software to at least one corresponding field of the web page [p. 4, paragraph 0046].

48. As to claims 87 – 89 and 94 – 101, these are product claims that correspond to method claims 4 – 6 and 11 – 18; see the rejections to claims 4 – 6 and 11 – 18 above, which also meet these product claims.

49. As to claims 92 and 93, these are product claims that correspond to method claims 9 and 10; see the rejections to claims 9 and 10 above, which also meet these product claims.

Conclusion

50. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 7,007,068 discloses a system for managing contact information and maintains a database with subscribers' updated contact information.

U.S. Patent Application Publication No. 2003/0069874 discloses a system to automate the updating of personal information.

U.S. Patent Application Publication No. 2003/0182391 discloses a system for providing remotely accessible Personal Information Manager.

CONTACT INFORMATION

51. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li B. Zhen whose telephone number is (571) 272-3768. The examiner can normally be reached on Mon - Fri, 8:30am - 5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Thomson can be reached on 571-272-3718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Li B. Zhen
Examiner
Art Unit 2194

LBZ



7/23/2007